Mail Stop Appeal Brief – Patents

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Charles A. Eldering.

Conf. No.:	8089	: Group Art Unit:	2623
Appln. No.:	09/742,852	: Examiner:	James R. Sheleheda
Filing Date:	21 December 2000	: Attorney Docket No.:	T721-19

Title: System for rescheduling and inserting advertisements

APPELLANT'S REPLY BRIEF TO THE EXAMINER'S ANSWER

In response to the Examiner's Answer dated July 31, 2007, and further to the Appeal Brief filed January 19, 2007, as amended in the Response to Notice of Non-Compliant Appeal Brief filed April 25, 2007, Applicant hereby submits a Reply Brief in accordance with 37 C.F.R. §41.41 for the above-referenced application.

A Request for Oral Hearing under 37 C.F.R. §41.47 is submitted herewith.

This Reply Brief is being filed in response to the Examiner's Answer, dated July 31, 2007 (Examiner's Answer). All of the arguments set forth in the Appellant's Appeal Brief, filed January 19, 2007 (Appeal Brief), are incorporated herein by reference.

RESPONSE TO EXAMINER'S ARGUMENTS

With respect to the Examiner's "Response to Argument" set forth at pages 10 – 13 of the Examiner's Answer, Applicant respectfully submits that the Examiner continues to misconstrue the teachings of U.S. Patent Application Publication No. 2003/0200128 to Doherty ("Doherty") and Doherty's combination with U.S. Patent No. 6,698,020 to Zigmond *et al* ("Zigmond").

A. The Examiner Incorrectly Applies Doherty's Teachings to the Claims.

i. Doherty's Schedule Change is Not Triggered Based On Program Content Change.

The Examiner argues that in Doherty, "[a] new schedule of advertisements will then be generated based upon ***a user profile*** (see paragraph 31 and 38 – 47). The user profile specifically contains user activity information, including current user activity information (see paragraph 31)." *Examiner's Answer, page 11 (emphasis in original).*

Applicant acknowledges that Doherty teaches using a user profile, among other components, to determine on what basis the items of information may be prioritized. However, even if Doherty is read to teach that the schedule is altered based upon the user profile and/or the user's interaction, such a teaching does not have anything to do with the features recited in the claims. That is, Applicant respectfully points out that user interaction in Doherty – whether part of the user profile or not – does not teach that the schedule in Doherty is altered "as a result of the change detected," (i.e., the program content displayed) as recited in independent claims 4 and 90. Stated differently, in

independent claims 4 and 90, ***reordering of the queue is not dependent on a user interaction, but rather on a change in program content.*** In contrast, Doherty's schedule reordering is triggered solely on user interaction and has nothing to do with program content.

ii. Doherty's "user profile" Does Not Include Current Program Content.

The Examiner also argues that, "Doherty discloses generated [sic] a schedule of advertisements and altering that schedule based upon user interactions, ***such as the current content displayed to the user*** (restaurants; paragraph 31)." *Examiner's Answer, page 12 (emphasis added).* The Examiner thus suggests that, because Doherty's system includes and utilizes a user profile, Doherty therefore teaches that the user profile includes currently displayed program content on which the re-ordering of Doherty's schedule is based. This is simply an incorrect reading of Doherty.

Initially, Doherty does not teach or suggest that the user profile includes "***current*** user activity information" as argued by the Examiner. Rather, Doherty simply states,

> ...a user profile 170 is developed which can assist the scheduler 140 to schedule the most appropriate advertisements or other items of information for the user. For example, if the user accesses a menu for restaurants, the user profile 170 would indicate the user's interest in restaurants. This could be implemented by recording the key word "restaurant" along with the time that the user accessed the restaurant menu. *Doherty, paragraph 31.*

Doherty also suggests that the user profile may be updated. Thus, Doherty's teachings merely suggest that the user profile may reflect the user's activity, but do not suggest that the ***current activity*** is actually included in the profile.

Furthermore, even if Doherty's user profile includes the current user activity, such activity does not include the actual program content currently being displayed. Stated differently, even if Doherty is read to teach that the schedule is altered based upon the user's interaction, such a teaching does not mean that Doherty examines the ***current*** program content to determine the reordering. There is simply no teaching or suggestion

in Doherty, either explicit or implicit, that the "current conditions" that Doherty's system uses to prioritize advertisements and generate a schedule include currently displayed program content (be it program content displayed before or after a detected change in the content). The Examiner relies on paragraph 31 of Doherty, citing Doherty's example of a user selecting restaurant menu and the system (i.e., user profile) recording the keyword "restaurant". However, the mere fact that a user's selection of a restaurant menu is included within that user's profile does not at all teach or suggest that the user profile or anything else on Doherty's system reorders the schedule "according to the program content displayed as a result of the change detected." In fact, the Examiner's own example supports Applicant's position: if Doherty actually reordered the schedule according to the program content displayed as a result of a change in the current content, then Doherty's disclosure would have stated as such, and not that the user profile reflected a keyword and the time of such activity, as described in paragraph 31 of Doherty. Accordingly, Thus, Doherty does not teach or suggest that the new or altered schedule is in any manner dependent on program content that is displayed as a result of a change in program content.

B. The Combination of Zigmond and Doherty Lacks All Elements of the Claims.

The Examiner insists that Zigmond is relied on for the teaching of selecting advertisements according to displayed program content. *Examiner's Answer, page 12.* However, Applicant reiterates that such a teaching does result in Applicant's claims, even when Doherty's schedule is applied to Zigmond's system. This is because Doherty does not teach or suggest that the new or altered schedule is in any manner dependent on, based on or modified according to the actual program content, as recited in the claims. Therefore, Doherty's schedule, when placed in combination with Zigmond, cannot be reordered or modified according to program content displayed as a result of the detected change.

The mere fact that Zigmond selects a new advertisement according to displayed program content does not mean that Zigmond would teach doing anything to Doherty's schedule with respect to the displayed program content. Applicant respectfully directs attention of the Board to the arguments set forth at page 11 – 12 of the Appeal Brief, and summarized here: even if Doherty's schedule is incorporated into Zigmond's system, **it cannot be inferred from such a combination that the included schedule would be reordered at all, let alone according to program content**. The Examiner is simply not entitled to assume that there would be any modification of Doherty's schedule according to program content simply because the schedule is now resident in Zigmond's system, as Zigmond does not teach or suggest the inclusion of a schedule.

Accordingly, Applicant respectfully submits that the combination of Zigmond and Doherty does not result in all features of the claims.

C. There is No Desirability to Combine Zigmond and Doherty.

The Examiner argues that there is motivation to combine Zigmond and Doherty, "so as to provide an advertising system which can respond to changing conditions while reducing delays and allowing the use of more compact compression techniques." *Examiner's Answer, page 11.* The Examiner also suggests that Doherty's system would allow more time to prepare and compile the ad. *Id.*

The Examiner seemingly ignores the fact that Zigmond's system already has the ability to select the desired advertisement(s) "on demand", thereby obviating the need for a modifiable schedule as suggested by the Examiner. There is simply no reason to add a schedule of ads to Zigmond's system. The whole purpose of Zigmond's ad selection and insertion system is to be able to select the ad that is best suited for insertion at or near the time of insertion – not prepare a schedule of ads well in advance as advocated by Doherty and the Examiner. As such, one skilled in the art would not necessarily think to add a schedule and a modification thereof (according to program content) as taught by Doherty to Zigmond's system. Moreover, the inclusion of Doherty's schedule in Zigmond would

effectively change the mode of operation of Zigmond, as Zigmond's system would be forced to use an ad schedule instead of an on-demand ad-selection process as disclosed. Accordingly, the Examiner's proposed combination of Zigmond and Doherty is improper.

Conclusion

In view of the foregoing, as well as the reasons set forth in the Appeal Brief, Applicant respectfully submits that the Examiner has not met the burden of *prima facie* obviousness to support the rejection of claims 4-6, 55, 56, 59, 60, 75, 78, 79, 90 and 91. Accordingly, for the reasons detailed herein and in the Appeal Brief, independent claims 4 and 90, and all claims dependent thereon, including claims 5, 6, 55, 56, 59, 60, 75, 78, 79 and 91, are allowable over the combination of Zigmond and Doherty. Applicants respectfully request that the Board reverse the Examiner's rejections of the claims and remand this application for issue.

Respectfully submitted,

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